REMARKS

Claims 55-76 are now pending in the application.

Claim Rejections – 35 U.S.C. § 103

The Patent Office rejected claims 55, 58, 60, 63, 67, 68, 69 and 71 under 35 U.S.C. § 103(a) as being unpatentable over Shigematsu et al. U.S. Publication No. 20020095588, ("Shigematsu") in view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher") in further view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle").

The Patent Office rejected claims 56, 57, 59, 61 and 62 under 35 U.S.C. § 103(a) as being unpatentable over Shigematsu et al. U.S. Publication No. 20020095588, ("Shigematsu") in view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher") in further view of Bashan et al., U. S. Patent No. 6,202,927, ("Bashan").

The Patent Office rejected claims 64-66 under 35 U.S.C. § 103(a) as being unpatentable over Shigematsu et al. U.S. Publication No. 20020095588, ("Shigematsu") in view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Elteto et al., U.S. Patent No. 7,111,324, ("Elteto").

The Patent Office rejected claims 70 and 72-75 under Shigematsu et al. U.S. Publication No. 20020095588, ("Shigematsu") in view of Mosher Jr., et al., U.S. Publication 20030173408, ("Mosher") in view of Doyle et al., U.S. Publication No. 20020095587, ("Doyle") in further view of Jachimowicz et al., U.S. Patent 5,734,154, ("Jachimowicz").

Applicant respectfully traverses each rejection under 35 U.S.C. § 103(a). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Additionally, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

Regarding amended claim 55, Applicant respectfully submits claim 55 recites elements which have not been disclosed, taught or suggested by Shigematsu, Bashan, Doyle, Elteto, Jachimowicz, O'Gorman and Mosher, individually or in combination. For example, claim 55 recites the transaction authentication card including "the processor being communicatively coupled to said biometric sensor and said memory and disposed in said housing, the processor performing enrollment of said biometric feature of said user to produce said stored biometric data in said memory without employment of a device external to said housing, said stored biometric data remaining solely within said memory, the processor having a fingerprint matching algorithm for comparing said biometric feature of said user with the stored biometric data and a serial number generation algorithm for generating a serial number based on the fingerprint matching algorithm."

Shigematsu fails to disclose, teach or suggest the recited elements of amended claim 55. In Shigematsu, the registered data, formed during an enrollment process, is acquired in advance. (Shigematsu, Paragraph [0072]). Paragraph [0075] of Shigematsu states "the storage unit which stores in advance the registered fingerprint data 12A to be collated with the fingerprint of the user." Shigematsu fails to disclose an enrollment process that is performed by the processor without employment of a device external to said housing of a transaction authentication card to produce the stored biometric data in

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the memory of the transaction authentication card. Bashan, Doyle, Elteto, Jachimowicz, O'Gorman and Mosher also fail to disclose, teach or suggest "the processor performing enrollment of said biometric feature of said user to produce said stored biometric data in said memory without employment of a device external to said housing, said stored biometric data remaining solely within said memory" as recited in claim 55. Under *In re Ryoka*, a *prima facie* case of obviousness has not been established for claim 55. Claims 56-76 should be allowed due to their dependence upon an allowable base claim.
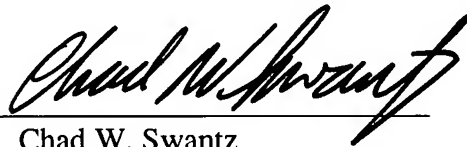
CONCLUSION

In light of the forgoing, entry of the amendment and allowance of the claims is earnestly solicited.

Respectfully submitted,

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